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PATENT
Docket No. 2456-2-13-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Phillip M. Adams)	
)	
Serial No.:	10/727,798)	
)	Art Unit:
Filed:	December 4, 2003)	3629
)	
For:	STUDENT-CENTERED, CROSS-INSTITUTIONAL)	
	CURRICULUM MANAGEMENT SYSTEM)	
	APPARATUS AND METHOD)	
)	
Examiner:	Gabrielle A. McCormick)	

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA, 22313-1450

Dear Commissioner:

In response to the Examiner's Answer mailed November 29, 2010, Appellant respectfully submits the following remarks.

REMARKS

Appellant has received and reviewed the Examiner's Answer mailed November 29, 2010. In so doing, Appellant recognized a need to withdraw an argument presented in the Appeal Brief filed September 27, 2010. Additionally, Appellant noted within the Examiner's Answer a factual error undercutting all of the claim rejections articulated in the Examiner's Answer. Accordingly, Appellant submits the following remarks in response to the Examiner's Answer.

I. Withdrawal of Argument

In the Appeal Brief filed September 27, 2010, Appellant argued that "Appellant does not find in any viable combination of the cited prior art any teaching or suggestion of determining equivalencies between courses before receiving any inputs from a student." However, in view of the Examiner's Answer, explaining its reliance on Wenger, Appellant concedes that the foregoing argument is more properly characterized as an improper combination, rather than a failure to identify the particular claim elements within the teachings of a prior art reference.

Accordingly, Appellant hereby withdraws the argument asserting a failure to identify within the cited prior art a teaching or suggestion of determining equivalencies between courses before receiving any inputs from a student. Appellant similarly withdraws the argument asserting a failure to identify with the cited prior art a teaching or suggestion of presenting a plurality of degrees to a student before receiving any inputs from a student.

II. The Examiner's Answer Errs by Maintaining a Combination of Two References That Teach Away from One Another

The Examiner's Answer errs in maintaining the combination of Wenger and Fields when the two references teach away from their combination. *See* MPEP §2145(X)(D)(2) (stating that

“[i]t is improper to combine references where the references teach away from their combination”); *see also In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983). Accordingly, the Examiner’s Answer does not set forth a proper *prima facie* case of obviousness.

Specifically, in its rejection of claims 1, 2, 4-8, 10-13, 17-20, and 23-25 the Examiner’s Answer relies on a various combinations that each include a combination of Wenger and Fields. However, Fields teaches against proceeding in the manner taught by Wenger.

Wenger teaches a “Course Equivalencies Subsystem” containing “information regarding equivalencies that have been formalized between the ACE and other program courses and college courses from partner schools.” *See* Wenger at ¶ 0036. Wenger further teaches that this “information is entered into this database through the Research system by the registrar or admissions personnel.” *Id.* (emphasis added); *see also* Wenger at ¶ 0023 (disclosing a training system providing registrars with protocols for developing equivalency awards). Accordingly, Wenger teaches reliance on skilled and authorized humans (i.e., registrar or admissions personnel) to make determinations of equivalences.

In contrast, Fields teaches against reliance on human-determined equivalences. Fields teaches that human-determined equivalences are “subjective,” “time-consuming,” and “prone to error.” *See* Fields at ¶ 0005. Accordingly, Fields advocates an “automated registrar” that automatically determines equivalencies and provides “an answer on-line and within seconds indicating the number of transferred credits that the system will grant provisionally.” *See* Fields at ¶¶ 0016-0017. Thus, Fields teaches against proceeding in the manner taught by Wenger.

Because Wenger and Fields teach away from their combination, they cannot properly be combined as part of an obviousness rejection. *See* MPEP §2145(X)(D)(2) (stating it is improper to combine references where the references teach away from their combination). Thus, the

Examiner's Answer does not present a proper *prima facie* case of obviousness for claims 1, 2, 4-8, 10-13, 17-20, and 23-25.

III. By Basing its Entire Defense of the Improper Combination of Wenger and Fields on an Inaccurate Factual Assertion, the Examiner's Answer Fails to Meet its Burden

In defending its improper combination of Wenger and Fields, the Examiner's Answer relies on an inaccurate factual assertion. Specifically, the Examiner's Answer asserts that it is permissible to combine Wenger and Fields because "Wenger is silent as to how equivalencies are determined." *See* Examiner's Answer at p. 17. This assertion is the sole justification provided by the Examiner's Answer in defense of the improper combination of Wenger and Fields. *Id.*

However, that required, underlying assertion is factually inaccurate. While Appellant has not found a direct statement in Wenger that "determinations of equivalency are determined by humans and not by computers," Appellant has found that the teachings of Wenger, taken as a whole, absolutely point in that direction. They are not silent (i.e. neutral) as asserted by the Examiner's Answer.

For example, Wenger teaches a system "serving registrars and school admissions personnel and saving them an estimated two to ten hours per applicant." *See* Wenger at ¶ 0023. The system "promotes equity in the awarding of academic credit" by providing "registrars with records of equivalency awards available at all partner schools." *Id.*

To ensure that the equivalences determined and entered by the registrars and school admissions personnel are reliable, Wenger provides "[t]raining subsystems designed for registrars and other users of the research system." *Id.* These training systems "include protocols for entering historical equivalencies and for developing future equivalency awards." *Id.*

Additionally, the system of Wenger “provides links to ACEnet and other program lists.” *Id.* “Registrars can access these lists during transcript analysis and the equivalency development process.” *Id.* To provide such access, Wenger teaches “mechanisms (for ongoing information-database development) by which registrars can input new data into containers for courses, program/licensure requirements, and equivalency containers, on an ongoing basis and periodic basis.” *See* Wenger at ¶ 0041.

Wenger further teaches that “Registrars access the Databank of Equivalencies and other research development systems using an assigned PIN. *See* Wenger at ¶ 0087. Accordingly, once the registrars are logged on, “[e]quivalency credits for courses at each school are entered on a course-by-course basis.” Moreover, to ensure that the equivalencies are kept up-to-date, schools are to “update their information several times a year and verify accuracy of program, course, and equivalency databases at least once a year.” *Id.*

In view of the foregoing, Appellant finds that, contrary to the assertions of the Examiner’s Answer, Wenger is not silent as to how equivalencies are determined. In particular, Wenger is not silent on whether the equivalencies stored with the “Database of Equivalencies” are determined by computer or by humans. Rather, Appellant finds that Wenger repeatedly emphasizes the direct involvement of registrars and school admissions personnel (i.e., humans) in determinations of equivalency, and teaches substantial training of those personnel to improve their proficiency.

To be clear, this human involvement is not limited to mere mindless data entry, but encompasses human decisions and judgments in determinations of equivalency. For this reason, Wenger repeatedly and consistently requires the involvement of registrars and school admissions personnel, who are typically the only persons equipped and authorized to make decisions and

judgments with respect to equivalency for a given school. If mere data entry were the only skill needed, it would be illogical for Wenger to explicitly call for the repeated involvement of such specialized personnel.

Additionally, it is for the same reason that Wenger teaches a training system providing the registrars and school admissions personnel with “protocols for entering historical equivalencies and for developing future equivalency awards.” *See* Wenger at ¶ 0023. Again, if mere data entry were all that was needed, it would be illogical, even unreasonable, for Wenger to explicitly call for substantive training in developing future equivalency awards.

Accordingly, by basing its entire defense of the improper combination of Wenger and Fields on an inaccurate factual assertion, the Examiner’s Answer fails to meet its burden. Thus, the Examiner’s Answer does not present a proper *prima facie* case of obviousness for claims 1, 2, 4-8, 10-13, 17-20, and 23-25.

IV. Conclusion

To establish a *prima facie* case of obviousness, the Examiner’s Answer must first find all of the claimed elements, then provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. With respect to claims 1, 2, 4-8, 10-13, 17-20, and 23-25, the Examiner’s Answer does not do this.

The Examiner’s Answer errs in maintaining a combination of Wenger and Fields, when the two references teach away from their combination. *See* MPEP §2145(X)(D)(2) (stating that “[i]t is improper to combine references where the references teach away from their combination”).

Moreover, the Examiner's Answer doubly errs by misstating the facts to justify its improper combination of Wenger and Fields. Accordingly, the Examiner's Answer does not properly set forth a *prima facie* case of obviousness.

Reversal of the rejections set forth in the Examiner's Answer is, therefore, respectfully requested.

DATED this 28th day of January, 2011.

Respectfully submitted,

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